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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86335576
Applicant	dPackaging LLC
Applied for Mark	DIGITAL REAL ESTATE
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Date	01/04/2016

# **APPEAL TO THE THE TRIAL AND TRADEMARK BOARD**

## **Applicant Opening Appeal Brief**

**January 4, 2016**

**Mark: DIGITAL REAL ESTATE (86/335,576)**

Pursuant to 15 U.S.C. §1070, the Applicant files this Appeal to the Trademark Trial and Appeal Board from a final decision of the Examiner in charge of the examination for the the mark “Digital Real Estate.” The Appeal was instituted on November 5, 2015, and a date of January 4, 2016 was set for the Applicant’s Opening Appeal Brief. Accordingly, the Applicant respectfully submits its Opening Appeal Brief in compliance with 37 CFR § 2.126 and 37 CFR § 2.142(b)(1).

### ***I. GENERAL BIOGRAPHICAL INFORMATION***

Word Mark: Digital Real Estate

Serial Number: 86/335,576

Filing Date: July 13, 2014

Goods and Services: A retail space for technology driven brands to showcase product and service offerings and to enable consumers to directly interact with and experience the brand, products, and services, namely, providing a live forum for companies to showcase, display, demonstrate and promote new and innovative ideas, products and services in the technology field; Advertising and showcasing the goods and services of others by providing a set of retail outlets in close proximity featuring goods and services that are offered for on-line sale.

Basis:	1B
Register:	Principal
Date of Appeal:	November 5, 2015
Applicant:	Packaging 22, LLC (a Nevada LLC) 18101 Von Karman Ave; STE 230 Irvine, CA 92162 (US)
Attorney	William J Kolegraff <a href="mailto:bkolegraff@twtlaw.com">bkolegraff@twtlaw.com</a> 619 602 2530

## ***II. DESCRIPTION OF THE RECORD***

July 13, 2014	Application filed
Sept. 8, 2014	First Office Action
March 9, 2015	Response to Office Action
May 5, 2015	Final Office Action.
Nov. 5, 2015	Appeal filed to the Trademark Trial and Appeal Board
Nov. 5, 2015	Appeal instituted
Jan. 4, 2016	Appeal Brief filed

## ***III. STATEMENT OF THE ISSUE***

There is only one issue barring registration on the principal register from the Final Office Action. All other issues have been resolved during normal prosecution.

ISSUE: Is the mark “Digital Real Estate” descriptive of the identified goods and services.

**IV. FACTS**

July 13, 2014

The applicant applied for registration of the word mark “Digital Real Estate” in IC 35 with goods and services identified as: “A retail space for technology driven brands to showcase product and service offerings and to enable consumers to directly interact with and experience the brand, products, and services; A set of retail outlets in close proximity for displaying and advertising goods and services that are offered for on-line sale.”

Sept. 8, 2014

The Examiner issued an Office Action, finding there were no conflicting marks that would bar registration under Trademark Section 2(d). The Examiner went on to find that the mark was merely descriptive:

The Examiner also required the applicant to modify the identification of goods and offered suggested text, which the Applicant adopted.

March 9, 2015

The Applicant filed a response to the Office Action. In the Response, the applicant modified its statement of goods to “A retail space for technology driven brands to showcase product and service offerings and to enable consumers to directly interact with and experience

the brand, products, and services; A set of retail outlets in close proximity for displaying and advertising goods and services that are offered for on-line sale,” as suggested by the Examiner.

May 5, 2015

The Examiner issued a Final Office Action.

Nov. 5, 2015

The Applicant filed an appeal of the Examiner’s decision to the Trademark Trial and Appeal Board

Nov 5, 2015

The appeal of the mark “Digital Real Estate” was instituted.

Jan. 4, 2016

Due date for the Applicant’s Appeal Brief

**V. ARGUMENT**

In part, *15 U.S.C. §1052* states that:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it .... (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them....

In the Final Office Action, the Examiner refused to register the mark “Digital Real Estate,” alleging that it is descriptive of the identified services. However, as set out below, the Applicant submits that the mark is not descriptive at all, but is only suggestive.

In the Final Office Action, the Examiner sets out several articles that use the term “digital real estate,” and ends with this summarizing statement:

Digital real estate is space on the Internet. The applicant’s services of live forum for companies to showcase, display, demonstrate and promote new and innovative ideas, products and services in the technology field, and the advertising the goods and services will feature digital real estate, so that people and businesses can preview the goods or services in person before purchase. The applicant will provide a venue in which sellers of digital real estate can showcase and advertise it to potential purchasers.

However, the identified services are to:

**A retail space** for technology driven brands **to showcase product and service offerings** and to enable consumers to directly interact with and experience the brand, products, and services, namely, providing a **live forum** for companies to showcase, display, demonstrate and promote new and innovative ideas, products and services in the technology field; Advertising and showcasing the goods and services of others by providing **a set of retail outlets** in close proximity featuring goods and services that are offered for on-line sale.

As set forth, the services are to A RETAIL SPACE and to A SET OF RETAIL OUTLETS. These are physical locations that can be used to SHOWCASE PRODUCTS AND SERVICES in a LIVE FORUM. No identified service is “space on the Internet,” which is the description that the Examiner uses for Digital Real Estate.

Using the Examiner's language, it is clear that the applicant's use of A RETAIL SPACE and A SET OF RETAIL OUTLETS is not descriptive of "Space on the Internet." Instead, the applicant identifies live, physical retail spaces for having live in-person customers interact with the technology. Thus, there is nothing about "digital real estate" that is descriptive of such a physical retail outlet or space.

**VI. SUMMARY**

For the reasons stated above, the Applicant respectfully submits that the mark "Digital Real Estate" is not merely descriptive of the identified services. According, the Board should advance the mark to registration on the Principal register.

Respectfully submitted,

William J Kolegraff

Attorney for Applicant